

Application No. 10/566,051
AMENDMENT dated June 1, 2009
Response to the Office Action of March 27, 2009

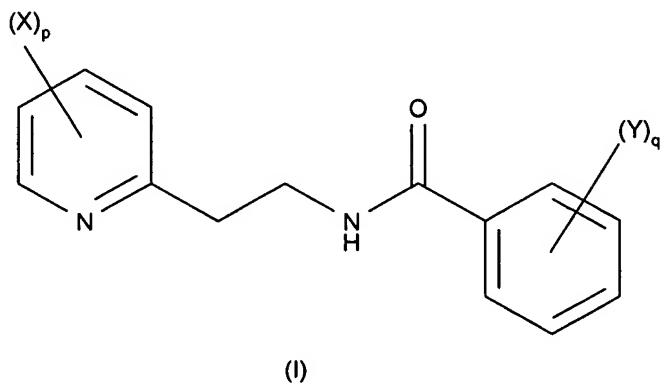
REMARKS/ARGUMENTS

Claims 1 through 12, 18, 20, and 21 are pending in the application. Claims 1 through 12, 18, and 21 are amended, and claims 13 through 17 and 19 are canceled.

In amending the specification the Applicants, for convenience, refer to Publication No. US 2006/0246102, the publication of the present application. Paragraph [0189] of that publication is amended by adding a moiety, $(Y)_p$, to the phenyl ring of structural formula (Ia) of the benzamide group. It is submitted that this amendment adds no new matter to the specification because structural formula (Ia) is shown at a number of places in the specification as having such a structure. Claim 18 is similarly amended.

Claims 1 through 12, 18, 20, and 21 are rejected under 35 U.S.C. § 102(e) as being anticipated by Mansfield et al. (WO 2004/016088). This rejection is respectfully traversed.

The Mansfield et al. reference is directed to a compound of general formula (I):



in which p is an integer equal to 1, 2, 3 or 4; q is an integer equal to 1, 2, 3, 4 or 5; **each substituent X is chosen, independently of the others, as being halogen, alkyl or haloalkyl, at least one of the**

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substituents being a haloalkyl; each substituent Y is chosen, independently of the others, as being halogen, alkyl, alkenyl, alkynyl, haloalkyl, alkoxy, amino, phenoxy, alkylthio, dialkylamino, acyl, cyano, ester, hydroxy, aminoalkyl, benzyl, haloalkoxy, halosulphonyl, halothioalkyl, alkoxyalkenyl, alkylsulphonamide, nitro, alkylsulphonyl, phenylsulphonyl or benzylsulphonyl; as to the N-oxides of 2-pyridine thereof; with the exception of N-{2-[3-chloro-5-(trifluoromethyl)-2-pyridinyl]-ethyl}-2,6-dichlorobenzamide.

Thus, the pyridine ring of the compounds of the reference *must be substituted* with at least one haloalkyl group. In the compounds of the present invention, on the other hand, the pyridine ring has substituents thereon designated R¹ and (X)_n, neither of which can be a haloalkyl group. Accordingly, the compounds of the reference do not read on the compounds of the present application. It therefore follows that the present invention cannot be anticipated by Mansfield et al.

It is therefore requested that the rejection of claims 1 through 12, 18, 20, and 21 under 35 U.S.C. 102(e) as being anticipated by Mansfield et al. be withdrawn.

Claims 1 through 12, 18, 20, and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mansfield et al.

The Examiner has helpfully pointed out that the Mansfield et al. reference has a common inventor with the instant application and that, based on the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. § 102(e). The Examiner has also pointed out that this rejection might be overcome by showing that the reference is disqualified under 35 U.S.C. § 103(c) as prior art in a rejection under 35 U.S.C. § 103(a).

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The present application has been published as U.S. 2006/0246102.

Mansfield et al. list nine persons as inventors. Four of these inventors are also listed as inventors of the present case. Additionally, the present case lists Marie-Claire Grosjean-Cournoyer and Pierre Genix as inventors. These persons are not listed as inventors in Mansfield et al. Similarly, Mansfield et al. list Tracey Cooke, Peter Stanley Thomas, Jean-Pierre Vors, Geoffrey Gower Briggs, and Helene Lachaise as inventors, none of whom is listed as an inventor of the present case.

On May 12, 2009, a search was conducted via PAIR of the assignment records of the USPTO. The search revealed:

Publication No. 2006/0246102 is assigned to Bayer Cropscience S.A. of 15 Rue Jean-Marie Leclair, F-69009 Lyon, France. The assignment was recorded April 18, 2006, on reel 017817 at frame 0093.

Publication No. 2005/0234110, the equivalent of WO 2004/016088, is assigned to Bayer Cropscience S.A. of 16 Rue Jean-Marie Leclair, F-69009 Lyon, France. This assignment was recorded June 9, 2005, on reel 016763 at frame 0924. Accordingly, it is submitted that the Mansfield et al. reference is disqualified under 35 U.S.C. § 103(c) as prior art in the current rejection under 35 U.S.C. § 103(a). It is therefore requested that the rejection of claims 1 through 12, 18, 20, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Mansfield et al. be withdrawn.

Claims 1 and 18 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement because, according to the Examiner, “The expressions ‘metallic

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complexes' and 'metalloidic complexes' are employed with considerable abandon in claims 1 and 18 with no indication given as to what complexes really are."

Claims 1 and 18 are now amended so that the expressions "metallic complexes" and "metalloidic complexes" no longer appear therein. Accordingly, it is requested that the rejection of claims 1 and 18 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement, be withdrawn.

Claim 21 is rejected under 35 U.S.C. § 112, first paragraph, because, according to the Examiner, the specification, while being enabling for treating fungi on crops, does not reasonably provide enablement for the prevention of fungi on crops.

Reference to preventively combating phytopathogenic fungi of crops has been deleted from claim 21. Accordingly, it is requested that the rejection of claim 21 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement, be withdrawn.

Claims 1, 12, and 18 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that the Applicants regard as the invention. Specifically, according to the Examiner:

the expressions "metallic complexes" and "metalloidic complexes" in claim 1 are indefinite; the expression "which may be" in claim 12 is indefinite because it suggests that the variables have other groups not contemplated by the Applicants;

the term "general" in claims 1, 12, and 18 is indefinite because it suggests that the compounds have other structures not contemplated by the Applicants; and

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the plural 's' on salts, oxides, and complexes makes claims 1 and 18 read on mixtures rather than on specific compounds.

Claims 1, 12, and 18 are amended to delete all occurrences of "metallic complexes," "metalloidic complexes," "which may be," and "general."

Claim 1 and claim 18, via its dependency upon claim 1 via claim 12, have also been amended to change "as well as its salts, N-oxydes, metallic and metalloidic complexes" to "as well as a salt or N-oxide thereof." Accordingly, it is requested that the rejection of claims 1, 12, and 18 under 35 U.S.C. § 112, second paragraph, be withdrawn.

Claims 1 through 11, 20, and 21 have been provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over the claims of co-pending Application No. 10/582,693 in view of Cooke et al.

As pointed out in the Office Action, a timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application.

The present application and U.S. Patent Application No. 10/582,693 are commonly owned by Bayer Cropscience S.A.

A terminal disclaimer under 37 C.F.R. § 1.321(b) and (c) disclaiming, with the customary exceptions, the terminal part of the statutory term of any patent granted on the instant application that would extend beyond the expiration date(s) of the full statutory term(s) of any patent(s) issued on U.S.

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Patent Application No. 10/582,693 is filed herewith. Accordingly, it is requested that the provisional rejection of claims 1 through 11, 20, and 21 on the ground of non-statutory obviousness-type double patenting as being unpatentable over the claims of co-pending Application No. 10/582,693 in view of Cooke et al. be withdrawn.

Claims 2 through 11 and 18 are objected to because the term "oxides" was misspelled in claims 1 and 18 and the term "characterized" was misspelled in claims 2 through 11. The claims have now been amended to change "oxydes" to "oxides." The term "characterized" or "characterised" no longer appears in the claims. Accordingly, it is requested that the objection be withdrawn.

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration is requested.

Respectfully submitted,



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